

REMARKS/ARGUMENTS

The Examiner is requiring restriction to one of the following groups:

- Group I: Claim 1, drawn to a process for preparing perylene-3,4:9,10-tetracarboxylic diimides of formula I;
- Group II: Claim 2, drawn to a process for preparing perylene-3,4:9,10-tetracarboxylic dianhydride; and
- Group III: Claims 3-5, drawn to compounds of formula IIb and a process for preparing these compounds.

Applicants hereby elect Group I, Claim 1, drawn to a process for preparing perylene-3,4:9,10-tetracarboxylic diimides of formula I, with traverse on the grounds that no adequate reasons and/or examples have been provided to support a conclusion of patentable distinctiveness between the identified groups. Also, it has not been shown that a burden exists in searching the claims of the three groups.

Moreover, the M.P.E.P. at § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants respectfully submit that a search of all of the claims would not impose a serious burden on the Office.

Finally, it should be pointed out that the passage from the PCT Administrative Instruction Annex B (Part 1(e)(i)) cited by the Examiner does not apply in the instant application. That passage relates to combinations of different claims encompassing independent product, process and use claims. Part 1(e)(i) is merely an illustration of a particular situation and other situations are of course conceivable which still preserve unity of invention required under PCT Rules 13.1 and 13.2.

This application currently contains three independent process claims (1-3) and an independent product claim (5). All of these claims are linked so as to form a "single general inventive concept" as required by PCT Rule 13.1. PCT Rule 13.2 defines the method for determining whether unity of invention is satisfied for a group of inventions, through the requirement of a technical relationship, as it is the case for the application at hand.

Claim 3 recites a process for the preparation of the starting material required in the processes of Claims 1 and 2. The subject matter of Claim 5 is related to the products of the process of Claim 4 and is novel. Therefore, Claims 3 and 5 can be considered as reciting an intermediate (and a process of making it) which is then used in the inventive processes recited in Claims 1 and 2. The requirement of PCT Rule 13.2 that the technical relationship among the group of inventions has to involve one or more of the same or corresponding "special technical features" is automatically satisfied by the intermediate.

This view seems to be supported by the fact that the EPO, acting as PCT search authority, has not questioned the unity of invention issue.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

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